


Application Number 	Application/Control No. 10/761,938	Applicant(s)/Patent under Reexamination SHAMS ET AL.	
Document Code - DISQ		Internal Document – DO NOT MAIL	

TERMINAL DISCLAIMER	<input checked="" type="checkbox"/> APPROVED	<input type="checkbox"/> DISAPPROVED
Date Filed : March 29, 2006	This patent is subject to a Terminal Disclaimer	

Approved/Disapproved by:
Henry D. Jefferson

T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

Date:	<input type="text" value="30-Mar-06"/>	APPL. S. N:	<input type="text" value="10761938"/>
To Examiner:	<input type="text" value="TABATABAI, ABOLFAZI"/>	Art Unit	<input type="text" value="2625"/>
From	<input type="text" value="Jefferson, Henry"/> PARALEGAL SPCECIALIST	Return This Memo To: Case Drop-Off Location	<input type="text" value="JEF-2D68"/>

SUBJECT: Decision on Terminal Disclaimer(T.D.) filed:

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete,

please initial, date and return this memo to me. THANK YOU.

- The T.D. is PROPER and has been recorded (see 14.23).
- The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see 14.24):
- The TD fee of has not been submitted nor is there any authorization in the application file for the use of a deposit account
 - The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application/patent (see 14.26 & 14.26.01).
 - The T.D. lacks the enforceable only during common ownership clause - needed to overcome a non-statutory double patenting rejection, Rule 321(b) (see 14.27.01).
 - The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be for a terminal portion of the term of the entire patent to be granted" (MPEP 1490) (see 14.26 & 14.26.02).
 - The person who signed the T.D.:
 - is not an attorney "of record" (see 14.29 and 14.29.01).
 - has failed to state his/her capacity to sign for the business entity (see 14.28).
 - is not recognized as an officer of the assignee (see 14.29 & possible 14.29.02).
 - No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see 14.30).
 - The T.D. is not signed (see 14.26 & 14.26.03).
 - The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see 14.32).
 - The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see 14.26, 14.27.02 or 14.26.05).
 - The period disclaimed is incorrect or not specified (see 14.26, 14.27.02 or 14.26.03).
 - Other:
 - Suggestion to request refund (see 14.36). NOTE: If already authorized, credit refund to deposit account and do not check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex.Initials: _____ Date: _____

Log Date: _____

TERMINAL DISCLAIMER
U.S. Application Serial No.: 10/761,938
Attorney Docket No. 016472-0311710

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE PATENT APPLICATION OF: Soheil SHAMS *et al.*
SERIAL NO.: 10/761,938
ATTORNEY DOCKET NO.: 016472-0311710
FILING DATE: January 21, 2004
ART UNIT: 2625 CONFIRMATION NO.: 2161
EXAMINER: Abolfazi Tabatabai
FOR: SYSTEM AND METHOD FOR AUTOMATICALLY PROCESSING MICROARRAYS

TERMINAL DISCLAIMER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

Dear Sir:

The undersigned, on behalf of the petitioner, **BioDiscovery, Inc.**, represents that the petitioner, **BioDiscovery, Inc.**, is the owner of the entire right, title and interest of:

(1) U.S. Application Patent No. 6,731,781 for SYSTEM AND METHOD FOR AUTOMATICALLY PROCESSING MICROARRAYS, by virtue of an Assignment to **BioDiscovery, Inc.**, from the inventors thereof, said assignment recorded on December 15, 1999, at Reel 010523, Frame 0014; and

(2) the above-captioned U.S. Application No. 10/761,938 by virtue of an Assignment to **BioDiscovery, Inc.**, from the inventors thereof executed on December 15, 1999, at Reel 015704, Frame 0721.

TERMINAL DISCLAIMER
U.S. Application Serial No.: 10/761,938
Attorney Docket No. 016472-0311710

Petitioner hereby certifies that the above-mentioned Assignments have been reviewed and to the best of petitioner's knowledge and belief, title is in petitioner who is seeking to take this action.

Petitioner hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the above-captioned U.S. Application No. 10/761,938, which would extend beyond the expiration date of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent No. 6,731,781, and hereby agrees that any patent so granted on the above-captioned U.S. Application No. 10/761,938 shall be enforceable only for and during such period that the legal title to U.S. Patent No. 6,731,781 shall be the same as the legal title to said patent issuing from the above-captioned U.S. Application No. 10/761,938, this agreement to run with any patent granted on U.S. Application No. 10/761,938 and to be binding upon the grantee, its successors or assigns.

Petitioner does not disclaim any terminal part of any patent granted on the above-captioned U.S. Application No. 10/761,938 prior to the expiration date of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent No. 6,731,781 in the event said patent later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321(a), has all claims canceled by a Reexamination certificate, or is otherwise terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

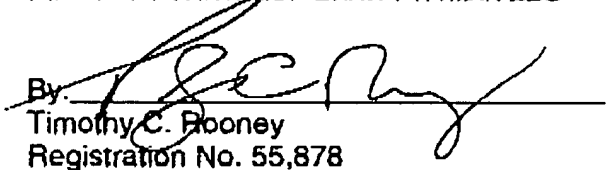
TERMINAL DISCLAIMER
U.S. Application Serial No.: 10/761,938
Attorney Docket No. 016472-0311710

The undersigned whose signature and title appear below is empowered to act on behalf of Petitioner.

Please charge the \$65.00 fee (Small Entity) for the filing of this Terminal Disclaimer to our Deposit Account No. 033975 (**Reference No. 016472-0311710**). Should this fee calculation be improper, please charge any deficiencies or credit any overpayments to our Deposit Account No. 033975 (**Reference No. 016472-0311710**).

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLC

By: 
Timothy C. Pooney
Registration No. 55,878

Date: March 29, 2006

PILLSBURY WINTHROP SHAW PITTMAN LLC
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PTO/SB/17 (12-04)
 Approved for use through 07/31/2006 OMB 0851-0032
 U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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Effective on 12/08/2004.
 Fees pursuant to the Consolidated Appropriations Act 2005 (H.R. 4918)

FEE TRANSMITTAL for FY 2005

<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Complete if Known	
		Application Number	10/761,938
		Filing Date	January 21, 2004
		First Named Inventor	SOHEIL SHAMS
		Examiner Name	Abolfazl Tabatabai
		Art Unit	2625
TOTAL AMOUNT OF PAYMENT (\$) (\$) 65		Attorney Docket No.	016472-0311710

METHOD OF PAYMENT (check all that apply)

Check
 Credit Card
 Money Order
 None
 Other (please identify) _____

Deposit Account
 Deposit Account Number: 033975
 Deposit Account Name: PILLSBURY WINTHROP SHAW FITTMAN LLP

For the above identified deposit account, the Director is hereby authorized to: (check all that apply)

Charge fee(s) indicated below
 Charge fee(s) indicated below, except for the filing fee

Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17
 Credit any overpayments

WARNING: Information on this form may become public. Credit Card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fee Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description	Small Entity Fee (\$)	Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims = 20 or MP = _____ **Extra Claims** = _____ **Fee (\$)** = _____ **Fee Paid (\$)** = _____
 MP = highest number of total claims paid for, if greater than 20
Indep. Claims = 3 or MP = _____ **Extra Claims** = _____ **Fee (\$)** = _____ **Fee Paid (\$)** = _____
 MP = highest number of independent claims paid for, if greater than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets = 100 + **Extra Sheets** = _____ / 50 = _____ **Number of each additional 50 or fraction thereof** = _____ **Fee (\$)** = _____ **Fee Paid (\$)** = _____

4. OTHER FEE(\$)

Non-English Specification: 150 fee (no small entity discount)
 Other: Terminal Disclaimer **Fee Paid (\$)** = 65.00

SUBMITTED BY

Signature: 	Registration No. (Attorney/Agent): <u>55,878</u>	Telephone: <u>703.770.7939</u>
Name (Print/Type): <u>Timothy C. Rooney</u>	Date: <u>March 29, 2006</u>	

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.